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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/663,241

09/16/2003

Pal Maliga

RUT.97-0097US1-DIV

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08/18/2006

EXAMINER

KUBELIK, ANNE R

DANN, DORFMAN, HERRELL & SKILLMAN
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SUITE 2400
PHILADELPHIA, PA 19103-2307

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 08/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/663,241	Applicant(s) MALIGA ET AL.	
Examiner Anne R. Kubelik	Art Unit 1638	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 August 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☒ Other: See Continuation Sheet.

Continuation of 3. NOTE:

New issues: Each limitation in claims 10 and 11 would require a separate search. Additionally, there are written description issues, as a representative number of all such promoters from all such plants have not been described.

New matter: there is only support in Example 1 and Fig 5 for *clpP*, *rpoB* and *atpP* NEP promoters from a small number of plant species, not from any plant species as encompassed by the claims. Example IV only provides support for the *rbcL*, *atpB*, *clpP* and 16S rDNA PEP promoters from rice, not from any plant species as encompassed by the claims.

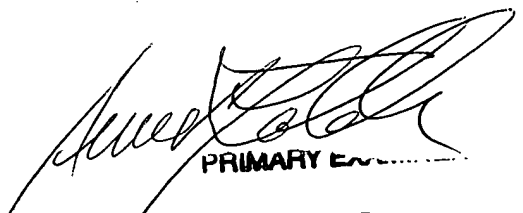
Continuation of 11. does NOT place the application in condition for allowance because:

112, 1st, written description. Applicant urge they disagree with examiner's positions for the reasons previously presented. This is not found persuasive for the reasons previously presented. Applicant urges that the recited function is that an NEP promoter is transcribed by a nuclear-encoded plastid polymerase and a PEP promoter is transcribed by a plastid encoded polymerase, thus the function of NEP and PEP promoters are provided. This is not found persuasive because structural and functional elements of the claimed promoters must be described. The structural elements are not described within the full scope of the claims. The specification describes an NEP promoter consensus that is present in some, but not all NEP promoters (pg 21-22). No PEP consensus is described. Applicant urges that a single species can describe a genus, citing Example 9 of the written description guidelines. This is not found persuasive because in example 9, more than one DNA was isolated and shown to encode proteins with the specified activity. The claims were not drawn to any DNA that encode proteins with the specified activity, but to a subset of them. The instant case does not follow the fact pattern of Example 9. In the instant case, the instant claims are drawn to any promoter with the claimed functions. Such promoters are not described within the full scope of the claims. Applicant urges that they describe multiple species of NEP and PEP promoters. This is not found persuasive because NEP and PEP promoters were only described from a few genes and from a few plant species. Further, the specification could not describe the structural features in common with NEP promoters and in common with PEP promoters.

112, 1st, enablement: Applicant urges that example I-IV provide methods for identification of NEP and PEP promoters. This is not found persuasive because the examples do not teach how to make the claimed promoters, only how to assay. Since the specification fails to teach how to make the promoters, undue trial and error experimentation would be required to make and test potential nucleic acids.

102(e): Applicant urges that Logan et al is wholly silent as to the presence of an NEP promoter in the *rps16* promoter, and that the higher transcription rates seen in wild-type leaf tissue can be accounted for by a promoter containing only a PEP promoter, because such a promoter would exhibit higher relative transcription rates in wild-type than mutant leaf tissue. This is not found persuasive because Logan states that all plastid genes are transcribed in a PEP-deficient background (paragraph spanning the columns on pg 176). Thus, the *rps16* promoter is both a PEP and an NEP promoter.

Continuation of 13. Other: This application contains claims 1-4 drawn to an invention nonelected with traverse in the response filed 18 August 2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144). See MPEPj 821.01..



PRIMARY EXAMINER

ANNE KUBELIK, PH.D.
PRIMARY EXAMINER